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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,156	12/21/2000	Jari Maenpaa	061602-2150 (NC24435US)	5543
30542 7590 01/29/2007 FOLEY & LARDNER LLP P.O. BOX 80278 SAN DIEGO, CA 92138-0278			EXAMINER BAYAT, BRADLEY B	
			ART UNIT	PAPER NUMBER
			3621	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/29/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/741,156

Applicant(s)

MAENPAA ET AL.

Examiner

Bradley B. Bayat

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

This communication is in response to amendment filed on October 30, 2006.

- Claims 26-28 and 35 have been currently amended.
- Claims 13-36 remain pending.

Response to Arguments

Applicant's arguments filed as noted above have been fully considered but they are not persuasive.

Applicant argues that the term "delegate" as used in the claims refers to allowing a customer to assign authority of spending the tokens, rather than just spending it (response pp. 8-9). Biffar discloses that a voucher can be freely transferred without restrictions and a user can transfer the voucher from one user/device to another, while creating a new history/ownership log each time (see column 4, 7-8 and Fig 1-C and associated text). Applicant's contention that Biffar merely addresses making a payment with the voucher and does not disclose transferring the voucher to another as provided in the claimed invention is erroneous.

The arguments below were presented in the Examiner's previous action and are hereby incorporated:

Applicant's amendments and argument contend that Biffar fails to disclose a mechanism of placing restrictions on the delegate token, wherein the delegate is restricted or prevented (response pp. 9-10). Biffar discloses that vouchers can be easily transferred and restrictions placed by any assignor with parameters such as an expiration date, limitation on number of movements, add other information and add data to a voucher at the time of the transaction (column 11, lines 47-52; column 19, line 29-column 20, line 24). Furthermore, if the voucher is

Art Unit: 3621

identified as being illegitimate by transmission of identifying elements, the voucher is prevented from acceptance by a remote device without prior checking with the system operator (column 19, lines 1-9).

Applicant argues that the cited reference does not teach the use of a “delegate” as claimed in the instant application (response p. 8). Applicant further contends that the remote device of Biffar is involved in a transaction with the original customer only and is “silent as to the original customer ability to create any restrictions on the use of the voucher by the remote device. Id.

A delegate is described in the disclosure as an assignee of tokens, i.e., a parent can assign tokens to their children as delegates [0021]. Biffar discloses “[v]ouchers, according to the invention, can be passed from remote device to remote device and therefore from an individual to a business, from a business to an individual, from business to business, as well as from an individual to an individual (column 4, lines 50-55).” “Technically, a voucher can be transferred from a remote device to another remote device an infinite number of times without ever having to transfer the voucher back to the central system (column 11, lines 37-40).” “In addition, remote devices as well as the central system could, once connected, also authenticate each other before continuing transactions. Whenever a remote device is connected to the central system or whenever the remote device is connected to another remote device, the device identification numbers are transmitted and checked against previously received and in memory stored information and commands to possibly restrict further transactions. This could also be done by using any of the common challenge-response methodologies (column 9, lines 52-61).”

Applicant also argues that the claimed invention includes two separate entities, a delegate and a vendor, wherein the Biffar reference “only teaches a first device and a second device

Art Unit: 3621

(response p. 9). “ Biffar is directed to use of digital vouchers for online transactions “passed from remote device to remote device and therefore from an individual to a business, from a business to an individual, from business to business as well as from an individual to an individual (column 19, lines 32-43). Biffar clearly anticipates any combination of participants for issuing, transferring and utilizing the vouchers.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 13-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Biffar, U.S.

Patent 6,047,269.

As per the following claim, Biffar discloses:

Claims 13 (24-28). An electronic commerce system (method, device) comprising:

- at least one token, (figure 1B, remote device A 100),
- an issuer of at least one token, the at least one token issuable to a customer, (figure 1B, central system 200),
- the at least one token delegable by the customer to a delegate or spendable by the customer with a vendor which sells goods or services (figure 1B, remote device B 101; column 4, lines 50-55) and

Art Unit: 3621

-the delegate restricted to spending the at least one token with the vendor (figure 1B, remote device 101; column 2, lines 45-48) and wherein:

-the customer receives at least one token from the issuer, the at least one token being stored in a portable radio communication device of the customer (column 11, lines 4-20),

-the customer activates the at least one token for use in buying the goods or the services from the vendor (column 9, lines 48-50),

-the customer selects between spending the at least one token with the vendor to buy the goods or services (column 11, lines 21-34), or

-delegates the at least one token to the delegate via a radio communication device of the delegate such that the delegate can spend the at least one token with the vendor to buy the goods or services (column 11, lines 35-40).

14. A system according to claim 13 wherein: the vendor presents a spent token to the issuer who redeems the token for monetary value (column 13, line 49-62).

Claims 15 (16). A system according to claim 13(14) wherein: the at least one token provided by the issuer when the issuer has authenticated the identity of the customer is defined as at least one Pre Token represented as S(Rp, Auth, Ss) wherein S indicates an executable event in which Rp represents the Recipient, Ss represents the Sender and Auth is indicative of the goods/service (column 7, line 45-column 8, line 45; column 10, lines 25-38).

Art Unit: 3621

Claims 17 (18). A system according to claim 15 (16) wherein: the at least one PreToken is placed in a group (column 14, lines 12-32).

Claims 19 (20). A system according to claim 17 (18) wherein: the at least one PreToken or the group is assigned to provide a DelegatedToken given by, $\text{DelegatedToken} =$

$S(\text{PreToken}/\text{GroupToken}, \text{Dp}, \text{Cs})$, wherein S indicates an executable event in which the at least one PreToken or the group is transferred from the Customer (Cs) to the Delegate (Dp) (column 11, lines 35-column 12, line 38; column 13, line 49-column 14, line 32)

Claims 21 (22). A system according to claim 19 (20) wherein: the at least one PreToken, the group or the at least one Delegated Token is spent with the vendor to provide a SpentToken or a SpentDelegatedToken given by, $\text{SpentToken} = S(\text{PreToken}/\text{thegroup}, \text{Mp}, \text{Cs})$, wherein S indicates an executable event in which a PreToken or the group is spent by the customer (Cs) with the vendor (Mp), and $\text{SpentDelegatedToken} = S(\text{DelegatedToken}, \text{Mp}, \text{Ds})$, wherein S indicates an executable event in with the at least one DelegatedToken is spent by the delegate (Ds) with the vendor (Mp) (column 3, lines 56-65; column 16, lines 59-67).

23. A system according to claim 21 wherein: the vendor redeems the SpentToken or SpentDelegatedToken with the issuer to result in a RedeemedToken given by, $\text{RedeemedToken} = S(\text{SpentToken}/\text{SpentDelegatedToken}, \text{Ms})$, wherein S indicates an executable event in which a SpentToken or SpentDelegatedToken is redeemed by the vendor (Ms) (figure 6, redemption 6000; column 19, lines 38-43).

Claims 29 (30-34). An electronic token used in the system of claim 13 (24, 25, 26, 27, 28), wherein the electronic token includes at least one parameter specifying a use thereof (column 11, lines 48-52).

35. An electronic commerce system comprising:

- a first user terminal device associated with a first user (figure 1B, 100 remote device A;
- a second user terminal device associated with a second user (figure 1B, 101 remote device B);
- an account processor means associated with an issuer of electronic tokens (figure 1B, central system 200),
- transaction means associated with a vendor of obtainable goods or services(column 6, lines 57-64);
- the first user terminal device having means for communicating with the account processor means so as to obtain electronic tokens from the account processor means (figure 1B, 300 network for signal transport);
- means for storing the electronic tokens (column 7, lines 62-64; figure 4, remote device A memory 130);
- means for activating the electronic tokens for defining the obtainable goods or services from the vendor (column 8, lines 6-13),
- means for communicating with the second user terminal device so as to transfer the activatable electronic tokens to said second user terminal device (column 10, lines 39-56);

Art Unit: 3621

-the second user terminal device including means for receiving the electronic tokens from the first user terminal device (column 11, lines 21-34);

-means for preventing the transfer of the electronic tokens from the second user to any non-vendor (column 18, lines 47-66); and

-means for communicating with the transaction means so as to obtain the obtainable goods or services from the vendor in exchange for the electronic tokens (column 11, line 53-column 12, line 39).

36. An electronic commerce system comprising:

-a token issued and redeemed by an issuer (fig 6, 1000);

-a customer to whom the token is issued, the customer able to spend the token with at least one vendor or delegate the token to a delegate (fig 6, 2000, 3000, 4000);

-the delegate able to spend the token with the at least one vendor (fig 6, transaction); and

-the at least one vendor able redeem the token with the issuer (fig 6, 6000).

Although the Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action, the specified citations are merely representative of the teachings in the art as applied to the specific limitations within the individual claim. Since other passages and figures may apply to the claimed invention as well, it is respectfully requested that the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

-US Patent 6,205,435 B1 to Biffar.

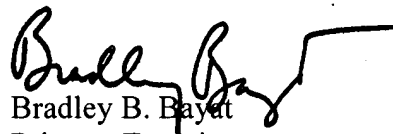
-US Patent 6,515,988 B1 to Eldridge et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The examiner can normally be reached on Tuesday-Friday 8 a.m.-6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Bradley B. Bayett
Primary Examiner
Art Unit 3621